

Express Mail No. EV475143180US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT APPLICATION

Applicants:	Max Aebi et al.	Confirmation No.:	4698
Application No.:	10/539,659		
Int'l Appln. No.:	PCT/CH02/00704	I.A. Filing Date:	December 17, 2002
For:	INTERVERTEBRAL IMPLANT WITH JOINT PARTS MOUNTED ON ROLLER BODIES	Attorney Docket:	8932-1179-999 (new) (formerly LUS-16089)

New York, New York 10017
September 14, 2006

Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION FOR FILING BY OTHER THAN
ALL INVENTORS UNDER 37 C.F.R. § 1.47(a)**

Sir:

Pursuant to 37 C.F.R. § 1.47(a), Robert Frigg, Dominique Burkard, Beat Lechmann, Paul Pavlov, and Robert Mathys Jr., joint inventors of the above-identified patent application, hereby petition for entry of their Declaration that they have executed on behalf of themselves and on behalf of Max Aebi, a joint inventor who has refused to join in the above-identified application.

In support of this Petition, applicants submit herewith a First Statement Of Facts by Carrie A. McPherson, a patent paralegal employed by Synthes, Inc., the controlling corporation of the assignee of the above-identified application, and a Second Statement Of Facts by Garry J. Tuma, the undersigned attorney for applicants. The two Statements detail proof of pertinent facts showing that Max Aebi has refused to join in the above-identified application.

The last known address of Max Aebi is as follows:

MEM Research Center
University of Bern
Stauffacherstrasse 78
CH-3014 Bern
Switzerland

Applicants respectfully request that this Petition be granted and that their Declaration be entered.

Respectfully submitted,



Garry J. Tuma
Registration No. 40,210
Attorney for Applicants

JONES DAY
Customer No. 51832
222 East 41st Street
New York, New York 10017
(212) 326-3939

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT APPLICATION

Applicants:	Max Aebi et al.	Confirmation No.:	4698
Application No.:	10/539,659		
Int'l Appln. No.:	PCT/CH02/00704	I.A. Filing Date:	December 17, 2002
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Hon. Commissioner for Patents
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Alexandria, VA 22313-1450

**FIRST STATEMENT OF FACTS
IN SUPPORT OF A
PETITION FOR FILING BY OTHER THAN
ALL INVENTORS UNDER 37 C.F.R. § 1.47(a)**

Sir:

I, Carrie A. McPherson, a patent paralegal employed by Synthes, Inc., the controlling corporation of the assignee of the above-identified patent application, make this Statement in support of a Petition For Filing By Other Than All Inventors Under 37 C.F.R. § 1.47(a), submitted concurrently herewith, in connection with this application.

The joint inventors of the subject matter claimed in the above-identified patent application are Robert Frigg, Dominique Burkard, Beat Lechmann, Paul Pavlov, Robert Mathys Jr., and Max Aebi. All joint inventors except Max Aebi have executed a Declaration,

which I understand is being submitted concurrently herewith in reply to a February 14, 2006
Notification Of Missing Requirements Under 35 U.S.C. § 371.

On August 22, 2006, I forwarded via e-mail to joint inventor Max Aebi, at his last known e-mail address of max.aebi@memcenter.unibe.ch, a copy of the above-identified patent application and a Declaration. In my e-mail, I asked Dr. Aebi to indicate whether or not he is able/willing to sign the Declaration, and if so, to review, sign and date the Declaration and return it to me preferably before September 12, 2006. I attach as Exhibit A a copy of my August 22, 2006 e-mail to Dr. Aebi.

I also attach as Exhibit B copies of the delivery status notification e-mail and attached text files that I received, indicating that my August 22, 2006 e-mail to Dr. Aebi was successfully delivered.

As of this date, I have not received an executed Declaration or a reply to my August 22, 2006 e-mail.

Respectfully submitted,

September 13, 2006

Date

Carrie A. McPherson

Carrie A. McPherson
Patent Paralegal

Synthes, Inc.
1302 Wrights Lane East
West Chester, Pennsylvania 19380
(610) 719-5231

Attachments: Exhibits A and B

EXHIBIT A
Page 1 of 2



<Mcpherson.Carrie@synthes.com>

08/22/2006 11:04 AM

To <max.aebi@memcenter.unibe.ch>

cc <Rauker.Robert@synthes.com>

bcc

Subject FW: PLEASE REVIEW AND REPLY Documents for
execution - Our Ref. 00093-05PUS1 (JD Ref.
8932-1180-999)

Dr. Max Aebi
Director MEM Research Center for Orthopedic Surgery
Institute of Evaluative Research in Orth. Surgery
University of Bern
Stauffacherstrasse 78
CH-3014 Bern

Re: U.S. Patent Application No. 10/539,659
Filed June 14, 2005
Corresponding to PCT/CH02/00704
Titled "Intervertebral Implant With Joint Parts Mounted On
Roller Bodies"
(00070-05PUS1; 8932-1179-999; LU1981)

U.S. Patent Application No. 10/539,660
Filed June 14, 2005
Corresponding to PCT/CH02/00705
Titled "Intervertebral Implant With Tilttable Joint Parts"
(00093-05PUS1; 8932-1180-999; LU1982)

U.S. Patent Application No. 10/538,542
Filed June 10, 2005
Corresponding to PCT/CH02/00706
Titled "Intervertebral Implant Comprising Joint Parts That Are
Mounted To Form A Universal Joint"
(00083-05PUS1; 8932-1181-999; LU1983)

U.S. Patent Application No. 10/538,950
Filed June 14, 2005
Corresponding to PCT/CH02/00707
Titled "Intervertebral Implant"
(00082-05PSU1; 8932-1182-999; LU1984)

Dear Dr. Aebi:

Attached please find a Declaration for each of the above-identified patent applications in which you are named as an inventor. Also attached is a copy of each application as filed in the U.S. Patent and Trademark Office.

We understand from the University of Bern that you are not permitted to sign the Declarations. Please confirm that you are following the University's instructions in your refusal to sign or if you otherwise cannot or will not sign the Declarations (you do not have to tell us why).

If, however, you are able/willing to sign the Declarations, please review the attached applications and, if they are in order, please sign and date the Declarations where indicated. If any minor changes need to be made to your name and address, please make the corrections and then

EXHIBIT A
Page 2 of 2

initial and date the changes.

Please return the executed Declarations to me at your earliest convenience and preferably before September 12, 2006.

It is important that you let us know whether or not you are willing to execute the attached Declarations. If you refuse, the U.S. Patent and Trademark Office has a special procedure we can follow.

With best regards.

Carrie

Carrie A. McPherson
Patent Paralegal
Synthes, Inc.
1302 Wrights Lane East
West Chester, PA 19380
Ph: 610-719-5231
Fax: 610-719-5143
<mailto:mcphee@synthes.com>

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 10539,659 Application as filed.pdf  10539,659 Declaration.pdf  10539,660 Application as filed.PDF  10539,660 Declaration.pdf
 10538,542 Application as filed.pdf  10538,542 Declaration.pdf  10538,950 Application as filed.pdf  10538,950 Declaration.pdf

EXHIBIT B
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From: E-mail Administrator - US
Sent: Tuesday, August 22, 2006 11:05 AM
To: McPherson, Carrie
Subject: Delivery Status Notification (Relay)

This is an automatically generated Delivery Status Notification.

Your message has been successfully relayed to the following recipients, but the requested delivery status notifications may not be generated by the destination.

max.aebi@memcenter.unibe.ch



ATT1860615.txt



ATT1860616.txt

ATT1860615.txt

Reporting-MTA: dns;netmail.synthes.com
Received-From-MTA: dns;us01-exchange2.synthes.com
Arrival-Date: Tue, 22 Aug 2006 11:04:24 -0400

Final-Recipient: rfc822;max.aebi@memcenter.unibe.ch
Action: relayed
Status: 2.5.0

ATT1860616.txt

From: <Mcpherson.Carrie@synthes.com>
To: <max.aebi@memcenter.unibe.ch>
Message-ID: <E4A1E544C8F52D42A6F6DDF256FA6AF501C96626@us01-exchange2.synthes.com>
Subject: FW: PLEASE REVIEW AND REPLY Documents for execution - Our Ref. 00093-05PUS1 (JD
Ref. 8932-1180-999)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT APPLICATION

Applicants:	Max Aebi et al.	Confirmation No.:	4698
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Hon. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**SECOND STATEMENT OF FACTS
IN SUPPORT OF A
PETITION FOR FILING BY OTHER THAN
ALL INVENTORS UNDER 37 C.F.R. § 1.47(a)**

Sir:

I, Garry J. Tuma, the undersigned attorney for applicants, make this Statement in support of a Petition For Filing By Other Than All Inventors Under 37 C.F.R. § 1.47(a), submitted concurrently herewith, in connection with the above-identified patent application.

The joint inventors of the subject matter claimed in the above-identified patent application are Robert Frigg, Dominique Burkard, Beat Lechmann, Paul Pavlov, Robert Mathys Jr., and Max Aebi. All joint inventors except Max Aebi have executed a Declaration, which is being submitted concurrently herewith in reply to a February 14, 2006 Notification Of Missing Requirements Under 35 U.S.C. § 371.

On August 22, 2006, after receiving a copy of Ms. Carrie A. McPherson's e-mail of even date to joint inventor Max Aebi (please see Ms. McPherson's Statement Of Facts submitted concurrently herewith), I performed an Internet search to confirm Dr. Aebi's mailing and e-mail addresses.

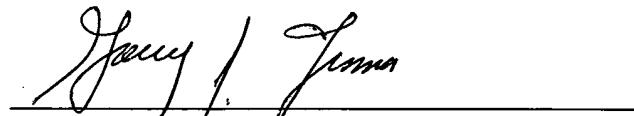
At the University of Bern's Web site, I confirmed that Dr. Aebi is the director of the Institute for Evaluative Research in Orthopaedic Surgery, his e-mail address is max.aebi@memcenter.unibe.ch, and his mailing address is as follows:

MEM Research Center
University of Bern
Stauffacherstrasse 78
CH-3014 Bern
Switzerland

See Exhibits 1-3; emphasis added.

I also attach as Exhibits 4 and 5, respectively, copies of August 10 and 16, 2005 letters from our foreign agent (Dr. Lusuardi AG) to applicants' former attorney (David E. Spaw, Esq., of Rankin, Hill, Porter & Clark LLP) indicating that joint inventor Max Aebi was already at that time refusing to sign any papers related to this patent application.

Respectfully submitted,



Garry J. Tuma
Registration No. 40,210
Attorney for Applicants

JONES DAY
Customer No. 51832
222 East 41st Street
New York, New York 10017
(212) 326-3939

Attachments: Exhibits 1-5

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History

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The Maurice E. Müller Institute for Biomechanics (MIB) was established as a joint venture between the Maurice E. Müller Foundation and the Medical Faculty of the University of Bern when Prof. M.E. Müller retired, in 1981, as Chairman of the Department of Orthopaedic Surgery at the Inselspital. The Maurice E. Müller Institute for Biomechanics attained the legal status of a full University Institute on January 1st, 1995. The MIB was directed from 1981 until 1988 by Prof. Stephan S. Perren and from 1989 until 2003 by Prof. Ernst B. Hunziker.

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In 2003 the MIB was dissolved and its parts were restructured: Prof. Hunziker became Director of the newly formed ITI Research Institute for Dental and Skeletal Biology and Prof. Lutz Nolte, a member of the MIB team since 1993, formed the new Institute for Surgical Technology and Biomechanics (ISTB). In conjunction with the newly created Institute for Evaluative Research in Orthopaedic Surgery (IEFO, formerly MEM-CED) directed by Prof. Max Aebi, the ISTB forms the University of Bern's M.E. Müller Research Center for Orthopaedic Surgery.

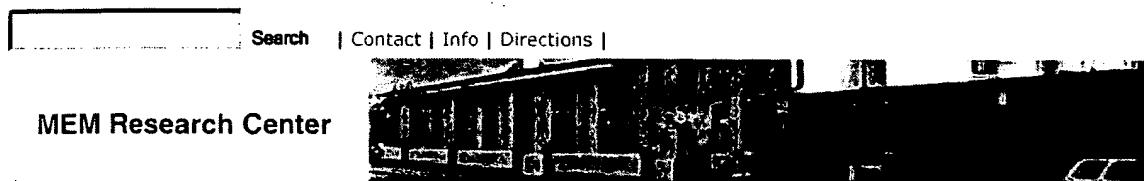
Together with clinical partners, this center realizes a unique concept for an integrated research continuum in the field of musculoskeletal science, from the bench (basic science), to the bedside (clinical application), and beyond (outcome).

In mid-2004 the MEM Research Center moved to its own facilities in the Wankdorf district of Bern. The 'new' building is actually a historical landmark, the Leinenweberei Schwob, which used to house a textiles manufacturing plant and in more recent times the Mechanical Engineering Division of the Fachhochschule Bern (University of Applied Science, [\[link\]](#)

MEM Research Center | Stauffacherstrasse 78 | CH-3014 Bern | Switzerland
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Matter-Walstra
Mellloh
Müller
Röder
Röösli
Schöni
Staub
Steffen
Tamcan
Widmer
Zimmermann
Zintel



Many people have joined and left us over the years.
For a list of former co-workers, [click here](#).

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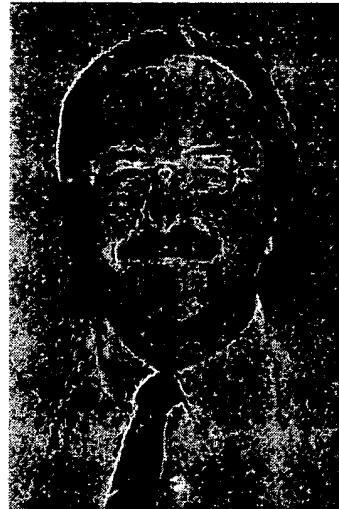
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MEM Research Center



Prof. Max Aebi, Dr. med, Dr. h.c.



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- [Medical Informatics and Documentation](#)

Position: Director

Phone: +41-31-631-5932

Email: max.aebi@MEMcenter.unibe.ch

- [Evaluative Clinical Research](#)

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Annual Report

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Intranet

Dr. Lusuardi AG

Patentanwaltsbüro

European Patent Attorneys
Conseils en propriété intellectuelle

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Bank UBS AG
 CH-8077 Zürich
Postcheck 80-30517-4

Ihr Zeichen Ihr Brief vom Unser Zeichen

LUS-16089

1981/US

Per telecopier only

Rankin, Hill, Porter & Clark LLP
Att. to Mr. Spaw
4080 Erie Street
Willoughby, Ohio 44094- 7836
USA

Datum August 10, 2005

**Re.: New national phase of PCT/CH02/00704 in the USA for
„Intervertebral implant with joint parts mounted on roller bodies“
in the name of Mathys Medizinaltechnik AG**

Dear Mr. Spaw,

Herewith we are informing that there are some internal problems between the applicant and the Inventor Prof. Max Aebi.

The reason of this problems is that Prof. Aebi is not willing to sign any documents in order to transfer the rights of the above mentioned Patent Application to the applicant.

Under this circumstances, we kindly ask you to prepare a respective document (Affidavit) to be signed by Mathys Medizinaltechnik AG (Mr. Robert Frigg, Chief Technology Officer), which enables the transfer of the above application to the applicant.

The outstanding Documents signed by the other Inventors will be sent to you as soon as possible.

Should you required more detail information, please let us know.

Looking forward to hearing from you, we remain with best regards.

Yours sincerely,

P. Kaiser

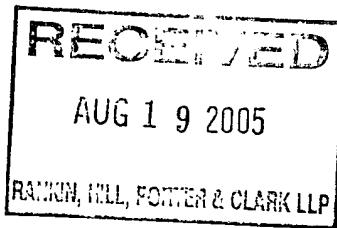


EXHIBIT 5

Dr. Lusuardi AG

Patentanwaltsbüro

European Patent Attorneys Conseils en propriété intellectuelle

Air mail

Briefadresse	Kreuzbühlstrasse 8 CH-8008 Zürich
Telefon	+41 (0)44 251 66 92
Telefax	+41 (0)44 251 75 74
E-Mail	lusuardi@lusuardi.ch
Bank	UBS AG CH-8077 Zürich
Postcheck	80-30517-4

Rankin, Hill, Porter & Clark LLP
Att. to Mr. Spaw
4080 Erie Street
Willoughby, Ohio 44094- 7836
USA

Ihr Zeichen

Ihr Brief vom

Unser Zeichen

Datum

August 16, 2005

LUS-16089

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8932-1179-999

**Re.: New national phase of PCT/CH02/00704 in the USA for
„Intervertebral implant with joint parts mounted on roller bodies“
in the name of Mathys Medizinaltechnik AG**

Dear Mr. Spaw,

Please find enclosed the Originals of the Declaration and Power of Attorney as well as the Assignment Document duly signed by all Inventors except of Prof. Max Aebi due to the problems mentioned in our letter of August 10, 2005.

Please file the enclosed Documents at your Patent Office as soon as possible. As soon as we receive the Document (Affidavit) from your side, we will forward it to our clients for signing.

We thank you very much for your cooperation in this matter.

Best regards.

Yours sincerely,

Encls.:

- Declaration and Power of Attorney (Original)
- Assignment Document (Original)